

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:
HAUMONT, Serge

Confirmation No.: 9553

Application No.: 09/806,939

Filed: May 8, 2001

Art Unit: 2617

For: IDENTIFYING A MOBILE STATION IN A
PACKET RADIO NETWORK

Examiner: PEACHES, Randy

REPLY BRIEF

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

This Reply Brief is being timely filed by right within two months of the Examiner's Answer mailed on January 3, 2008 as required under 37 C.F.R. §41.41(a), the due date being March 3, 2008.

The Director is authorized to charge the \$510.00 fee for filing a brief in support of appeal pursuant to 37 C.F.R. §41.20(b)(2). The Director is further authorized to charge any additional fees that may be due or credit any overpayment during the pendency of this application to Deposit Account No. **03-3975** under ref. no. 060258-0279245 from which the Undersigned Attorney is authorized to draw.

I. Purpose of the Reply Brief

The purpose of this Reply Brief is provide Appellants an opportunity to respond to what might be construed to be new points of argument raised in the Examiner's Answer and/or a failure of the Examiner to adequately address Appellants' previously submitted arguments, as well as allowing Appellants to respond to what are believed to be technically inaccurate characterizations of the applied art with respect to the rejections of the claims on appeal.

II. Administrative Correction to the Appeal Brief

As a minor administrative matter, in section I.A. of the Appeal Brief and as indicated in paragraph (1) of the Examiner's Answer, Appellants inadvertently identified "Nokia Corporation" as being the "Real Party in Interest", with reference to an assignment recorded at Reel/Frame no. 011816/0842.

Actually, the Assignment recorded at that reel/frame is to "Nokia Networks Oy", the previous corporate name of Nokia Corporation at the time of filing of the application. To ensure clarity of the record with respect to the Real Party in Interest, the Undersigned Attorney has recorded the change of corporate name from "Nokia Networks Oy" to "Nokia Corporation" in the USPTO Assignment Branch at Reel/Frame 020568/0660 on February 27, 2008. Appellants regret any inconvenience this unintentional oversight may have caused. Accordingly, the Real Party in Interest is now correctly stated as "Nokia Corporation".

III. Responsive Arguments

Appellants are not in disagreement with paragraphs (2) - (9) of the Examiner's Answer. Appellants maintain and incorporate by reference the arguments previously submitted in the Supplemental Appeal Brief filed on July 24, 2007, as further expanded below in response to the arguments presented in the Examiner's Answer.

A. Outline of Arguments

The specific issues addressed by Appellants in response to paragraph (10) of the Examiner's Answer are as follows and are addressed with respect to the rejection of each of the independent claims 7, 20, 25, 26, 28, and 31 on Appeal over Tiedemann et al. (US 6,381,454) ("Tiedemann") alone, or in various combinations with other secondary references:

1. Tiedemann fails to disclose the temporary identity *including* at least part of an identifier indicating a network element from which the temporary identity was allocated.
2. There is a substantive and non-trivial difference between Appellants' recitation of "*includes* at least part of an identifier", and the Examiner's reliance upon a reference (Tiedemann) that allegedly either suggests or inherently "*identifies*" the allocating network element.

3. Tiedmann teaches away from Appellants' claimed invention with respect to at least one limitation.
4. The Examiner's reliance upon "inherency" in providing a teaching or suggestion of the limitation(s) in question is legally flawed.

These issues relate to a general theme throughout the Final Rejection and the Examiner's Answer, and the supplemental arguments presented or reiterated below are submitted as being relevant to the rejection of each independent claim.

B. Arguments

1. Independent Claims 20, 25, 26, and 28

Independent claims 20, 25, 26, and 28 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Tiedemann et al. (US 6381454) ("Tiedemann"). Each of these claims include a limitation along the lines that the temporary identity allocated by the network element includes at least part of an identifier indicating the network element which allocated the temporary identity.

Applicants note that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims.¹ There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. §102.² To properly anticipate a claim, the reference must teach every element of the claim.³ “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”.⁴ “The identical invention must be shown in as complete detail as is contained in the ...claim.”⁵ In determining anticipation, no claim limitation may be ignored.⁶ In view of the foregoing authority, the cited reference fails to anticipate the claims on appeal.

In the interest of brevity, these claims will be addressed collectively. The limitations in question are variously formulated as follows:

¹ *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

² *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

³ See MPEP § 2131.

⁴ *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁵ *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁶ *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990).

Claim 20: "at least one network element configured to allow a temporary identity of at least one mobile station, *wherein the temporary identity includes at least a part of an identifier indicating the network element that allocates the temporary identity*" and "a database element configured to receive an inquiry including the at least part of the identifier of the network element that allocates the temporary identity."

Claim 25: "a mobile station for a cellular network, wherein the mobile station is configured to use a temporary identity allocated by a network element, *the temporary identity including at least a part of an identifier of a network element that allocates the temporary identity....*"

Claim 26: "wherein the mobile station is configured to use a temporary identity allocated by a network element, *the temporary identity including at least a part of an identifier of a network element that allocates a temporary identity.*"

Claim 28: "a network element...configured to allocate a temporary identity to at least one mobile station, *wherein the temporary identity includes at least a part of an identifier indicating the network element....*"

To reiterate, at least one difference between Appellants' claims on appeal and the disclosure of Tiedemann is the fact that, as recited in Appellants' claims, the temporary identity includes at least a part of an identifier indicating the network element that allocates the temporary identity. Tiedemann teaches that the TRN is allocated identifying the MSC and the MS of which it is being allocated to (column 2 lines 30-32). Appellants continue to highlight the difference between "includes the identifier of" in the claims on appeal, and "identifies" as taught by Tiedemann.

Appellants have previously argued that "includes" (as cited in the Appellants' claims) is not the same as "identifies" (which Tiedemann allegedly teaches in an *inherent* manner, with regard to the NANP numbering plan). In support of this argument, Appellants point out that Tiedemann fails to disclose, teach, or suggest *any* mobile station temporary identity that includes at least part of an identifier indicating the network element which allocated the temporary identity. Rather, Tiedemann merely discloses use of a Temporary Reference Number (TRN) which simply identifies the MSC which assigned the TRN. Specifically, Tiedemann teaches (see

col. 2:29-34) "[a] Temporary Reference Number (TRN) identifying the MSC and the mobile station is allocated for the mobile station at the mobile switching center. *The TRN can be a mobile station identification (MSID), a telephone directory number or any other number*" (*emphasis added*).

Although, Tiedemann appears to teach that the TRN "identifies" the MSC, Tiedemann clearly fails to disclose, teach or suggest that this "identification" is performed by incorporating at least part of an identifier indicating the MSC in the TRN. In fact, *Tiedemann discloses a contrary solution by indicating that the TRN can be "any number," including an MSID.*

Because a cellular network comprises a large number of network elements that engage in allocating temporary identities, however, *Appellants submit that it is simply impossible or a least technically infeasible for each MSID to include at least part of an identifier indicating each network element used to allocate a temporary identity to mobile stations.* Therefore, although Tiedemann appears to disclose that "the Temporary Reference Number (TRN) identifies the MSC," Tiedemann fails to provide any technical indication of *how* the TRN identifies the MSC.

Contrary to the Examiner's assertions, Tiedemann does not disclose, teach, or suggest these limitations wherein the temporary identity *includes* at least part of an identifier indicating the network element, *i.e.*, wherein the network element is used to allocate the temporary identity to the at least one mobile station.

Although this is an alleged anticipation rejection, Appellants point out that none of the secondary references of Sawyer, Onoe, or Monrad relied upon in the rejections of the remaining claims on appeal make up for this deficiency of Tiedemann, a deficiency which Appellants submit is representative of a common deficiency throughout the rejections of all the claims on appeal.

The "Response to Arguments" section of the Examiner's Answer states that "the Examiner submits that Tiedemann *inherently* teaches that the TRN (disclosed by Tiedemann) is a number which in comparison to the North American Numbering Plan (NANP) automatically *identifies* the MSC (network element) of which the MS is associated with" (*emphasis added*).

Throughout prosecution, especially in the Examiner's Answer, the Examiner impermissibly relies upon "anticipation by inherency" to justify his rejection of the independent claims by stating that Tiedemann *inherently* teaches that the TRN is a number, which, in comparison to the North American Numbering Plan (NANP), automatically identifies the MSC (network element) of which the MS is associated with, and further asserts that the identifier is also used for data transfer and for signaling. The Examiner alleges that Tiedemann provides support for this conclusion at cols. 2:30-32 and 6:29-50. The Examiner goes on to assert in the Answer that Tiedemann's teaching of the TRN is using the identifier in a "duality methodology", wherein the identifier is identifying both the MS and the associated MSC. However, Tiedemann is completely silent on any NANP numbering scheme.

Appellants submit that, in accordance with the MPEP⁷, the Examiner must provide a rationale or evidence tending to show inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.⁸ "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art."⁹ Appellants submit that the Examiner has failed to meet his burden in this regard.

In view of the above, Appellants submit that the only way that Tiedemann's asserted "any number" (col. 2:34) or MS identification would be able to identify the MSC is via some look-up scheme. Appellants further submit that such a complicated approach, if a solution at all, would be recognized by a person of ordinary skill in the art as a more awkward and less desirable implementation than in the Appellants' claimed invention. Furthermore, it is crystal clear that Tiedemann fails to disclose, teach, or suggest such a look-up table.

⁷ See MPEP 2112 (IV).

⁸ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

⁹ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (*emphasis* in original).

The Examiner's Answer effectively confirms this difference (the difference between Tiedemann's "identifies" and Applicant's "includes") by admitting that the NANP numbering plan is required to determine the identifier of the MSC which allocates the TRN. In other words, the Examiner effectively admits that Tiedemann, either alone or in combination with any other applied art reference, fails to disclose, teach, or suggest that the temporary identity includes at least a part of an identifier that indicates the network element that allocates the temporary identity, the crux of the issue relating to the claims on appeal.

Accordingly, in light of the deficiencies of the Examiner's rejections discussed above, reversal of the rejections and allowance of claims 20-22 and 25-28 by the Honorable Board are respectfully requested.

2. Independent Claim 7

Claim 7 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the combination of Tiedemann with Sawyer et al. (US 5920814), Onoe et al. (US 5361396), and Monrad (US 6208628).

Appellants respectfully point out that, to establish a *prima facie* case of obviousness, three basic criteria offer useful insights. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.¹⁰ Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.¹¹

The Supreme Court recently held that it is necessary, *inter alia*, for a court to look to interrelated teachings of multiple patents in order to determine whether there was an apparent reason to combine the known elements in the claimed. In this regard, the Court held "[t]o facilitate review, this analysis should be made explicit."¹² "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

¹⁰ See MPEP §2143.

¹¹ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and See MPEP §2143.

¹² *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ____ (2007) (see p. 14).

reasoning with some rational underpinning to support the legal conclusion of obviousness.”¹³

The Examiner has not met this burden, as discussed with more particularity below, and with reference to the previously presented arguments with respect to the anticipation rejection over Tiedemann.

Contrary to the Examiner's assertions, Tiedemann does not disclose, teach, or suggest the limitation of claim 7 that recites "using a network element having an identifier of its own to allocate a temporary identity to the at least one mobile station, wherein the temporary identity **includes** at least part of an identifier indicating the network element," *i.e.*, wherein the network element is used to allocate the temporary identity to the at least one mobile station. In the interests of brevity, the arguments presented above with respect to the anticipation rejection of independent claims 20, 25, 26, and 28 are incorporated herein by reference without restatement, particularly the arguments with respect to the inherency of Tiedemann's disclosure.

In fact, and even though Tiedemann appears to teach that the TRN "identifies" the MSC, as discussed above, Tiedemann clearly fails to disclose, teach or suggest that this "identification" is performed by incorporating at least part of an identifier indicating the MSC in the TRN. In fact, ***Tiedemann teaches away*** from the claimed invention by indicating that the TRN can be "***any number***," including an MSID.

Appellants note that is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.¹⁴ Further in this regard, As the Court of Customs and Patent Appeals, predecessor to the Federal Circuit, has held:

All relevant teachings of cited references must be considered in determining what they fairly teach to one having ordinary skill in the art. The relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention to one having ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention.¹⁵

¹³ See *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

¹⁴ *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986).

¹⁵ *In re Mercier*, 185 USPQ 774, 778 (CCPA 1975).

The rejections in the Official Action amount, in substance, to nothing more than hindsight reconstruction of Applicants' invention by relying on isolated teachings of the applied art, without considering the overall context within which those teachings are presented. Without benefit of Applicants' disclosure, a person having ordinary skill in the art would not know what portions of [Tiedemann, Sawyer, Onoe, and Monrad] to consider, and what portions to disregard as irrelevant or misleading.¹⁶

None of the other secondary references of Sawyer, Onoe, or Monrad make up for this glaring deficiency of Tiedemann which Appellants have pointed out is representative of a common deficiency throughout the rejections of all the claims on appeal. Specifically, none of the references cited by the Examiner discloses a "numbering plan". It is only through the use of impermissible hindsight, using Appellants' disclosure against them that the Examiner is forced to rely on four separate references, along with an "inherency" argument, while still not being able to show that the suggested combination of references discloses each limitation of Appellants' claimed invention.

Accordingly, in light of the deficiencies of the Examiner's rejections discussed above, reversal of the rejections and allowance of claims 3 and 7 by the Honorable Board are respectfully requested.

3. Independent Claim 31

Claim 31 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the combination of Wallentin (US 2002/0086685) with Tiedemann.

This claim includes a limitation similar to that discussed above, and is specifically formulated as follows:

Claim 31: "A radio station controller for a cellular network, configured to route data packets including a temporary identity allocated to a mobile station, *wherein the temporary identity includes at least part of an identifier indicating a network element which allocated the temporary identity....*"

¹⁶ *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965).

In the interest of brevity, the arguments presented above with respect to the unpatentability rejection of claim 7 and the anticipation rejection of claim 20 are incorporated herein by reference. In particular, appellants again note that *Tiedemann teaches away* from the claimed invention by stating that the TRN can be "any number".

Accordingly, in light of the deficiencies of the Examiner's rejections discussed above, reversal of the rejections and allowance of claim 31 by the Honorable Board are respectfully requested.

4. Dependent Claims

In the Examiner's Answer at subsection (C), the Examiner appears to allege that any claim depending on an allegedly unpatentable or obvious base claim is obvious by itself. Appellants submit that this is a gross mischaracterization of the law of unpatentability.

C. Conclusion

In light of the above arguments, particularly the fact that Tiedemann teaches away from the claimed invention, Appellants respectfully request reversal of all rejections and allowance of claims 3, 7, 20-22, and 25-31 in this Appeal.

Date: February 29, 2008

Respectfully submitted,

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